

REMARKS

This is a full and timely response to the final Official Action mailed **April 6, 2004** (Paper No. 9). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 1, 34 and 39 have been amended. Claims 1 and 34 are amended to correct obvious typographical errors. Claim 39 has been amended to include the recitations of claim 40, and claim 40 has been cancelled. Thus, claims 1-15, 17, 18, 20-25, 27-30, 34-39, and 41-43 are currently pending for the Examiner's consideration.

In the outstanding Office Action, claims 1-3, 5-6, 25-27, 34 and 35 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of the Handbook for Palm VII Organizer ("Palm Handbook") *taken alone*. For at least the following reasons, this rejection is respectfully traversed.

As Applicant pointed out previously, claim 1 recites:

A portable computing device, comprising:
a user interface having a touch-sensitive display that detects contact between an input device and the display;
a processor; and
a memory that stores a location indicated by a user on the display;
wherein said location is determined by detecting contact between the input device and the display, any movement of the input device across and in contact with the display and removal of the input device from the display; said location being where the input device is removed from the display and not where the input device initially contacts the display.

(emphasis added).

Similarly, claim 25 recites:

A method for entering data on a portable computing device having a memory, a processor, and a touch-sensitive screen, the method comprising:
detecting initial contact between an input device and the screen;

detecting any movement of the input device across and in contact with the screen;
detecting removal of the input device from the screen; and
saving a location corresponding to where the input device is removed from the screen and not where the input device initially contacts the screen.
(emphasis added).

Claim 34 recites:

A method for entering data on a portable computing device having a memory, a processor, and a touch-sensitive screen, the method comprising indicating a specific location on said screen by:
bringing an input device into contact with said screen at a first location other than said specific location;
sliding said input device across and in contact with said screen to said specific location; and
removing said input device from said screen at said specific location;
wherein said specific location is detecting and entered by detecting removal of said input device from said screen after bringing said input device into contact with said screen.
(emphasis added).

In contrast, none of the cited prior art teaches or suggests the subject matter recited in claims 1, 25 and 34. The recent final Office Action concedes this point stating that “Palm fails to explicitly teach a memory that stores a location indicated by a user of the display, wherein said location being where a[n] input device is removed from a display and not where said input device initially contacts said display.” (Paper No. 9, p. 3).

However, the Action goes on to allege, without any support in the prior art, that “[i]t would have been obvious to one skilled in the art, at the time of the applicant’s invention, to store a location in memory where an input device is removed from a display and not where the input device initially contacts the display, because by tracking only the instantaneous location of said contact point, where said input device is currently in contact with said display over time, the need to allocate additional free memory for the storage of data relating to the location history of said contact point is not needed, thus minimizing the total amount of

memory required by said portable computing device. The result of such being that only data stored in memory, after said input device is removed from said display, is the last location of said contact point when said input device is removed from said display.” (Paper No. 9, p. 3).

This rejection fails for several reasons.

First, no prior art reference teaches or suggests the claimed subject matter. The examiner has the initial burden of demonstrating that all the claimed features of the invention are taught by the prior art. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Case law has established that, *where the examiner relies on a single reference under § 103, it is legally insufficient to merely state that it would be obvious to modify the disclosure to include the features of the claimed invention.* *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

Second, the motivation for modifying the cited prior art given in the action, i.e., to minimize the amount of memory required, does not come from and has no support in the prior art. Motivation to modify a prior art reference must be supported by the prior art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Specifically, the Palm Handbook does not teach or suggest storing or saving a location where “said location [is] where the input device is removed from the display and not where the input device initially contacts the display” as recited in claim 1. The Palm Handbook similarly does not teach or suggest the subject matter of claims 25 and 34.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection

of claims 1-12, 25, and 27-37 based on the Palm Handbook should be reconsidered and withdrawn.

Dependent claims 21-24 also recite subject matter similar to that in claims 1 and 25. Consequently, the rejection of claims 21-24 should also be reconsidered and withdrawn for at least the reasons given above with respect to claims 1 and 25.

The final Office Action rejects claims 3, 4 and 39-43 as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of the Palm Handbook and U.S. Patent No. 5,384,862 to Kung et al. (“Kung”). For at least the following reasons, this rejection is also respectfully traversed.

Claim 4 further recites a “rocker arm [that] is movable in both a rotary direction and in a linear direction.” (See Applicant’s Specification, para. 32). Claim 39, as amended herein to include the recitations of cancelled claim 40, recites similar subject matter. This subject matter is also not taught or suggested by the prior art of record.

In this regard, the final Office Action cites Kung as teaching a bidirectional switch 88. According to the Action, the bidirectional switch which generates “pointing signals, in either clockwise or counterclockwise order, via the user of said left, right, up or down pointing signals is considered [as teaching a rocker arm movable in] a rotary direction.” (Paper No. 9, p. 8).

However, claims 4 and 39 recites a rocker arm that is movable in *both* a rotary direction and in a linear direction. Kung does not teach or suggest that the bidirectional switch 88 is moveable in both a rotary *and* a linear direction. Moreover, the final Office Action fails to indicate how or where such subject matter is taught by the prior art of record.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 4, 39 and 41-43 should be reconsidered and withdrawn.

Claims 13-15, 17-18, 20-22, 29-30 and 37-38 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook, the Remote Engineering Homepage (the "REH") and U.S. Patent No. 5,384,862 to Echerer et al. ("Echerer"). For at least the following reasons, this rejection is respectfully traversed.

Claim 13 recites:

A computer aided design (CAD) system, comprising:
a main computer that runs a desktop CAD program;
at least one portable computing device that runs a portable CAD program; and
a communication link between the main computer and the at least one portable computing device, wherein the portable CAD program and the desktop CAD program are complementary to allow data to be exchanged between the main computer and the portable computing device;
wherein the portable CAD program generates a script file comprising any additions or changes made with regard to a CAD file on the portable computing device, wherein the script file is separate from the CAD file.

The Palm Handbook is cited as teaching a portable computing device that can work with a main computer. The REH is cited as teaching a CAD program that runs on a portable computing device.

Echerer teaches that an x-ray taken for use by a doctor can be stored as an electronic bitmap file. The bitmap can be displayed as an image of the x-ray. Then, "processing enhances the image displayed and extracts information from the image as a result of an interchange of instructions and responses between CPU and user. The enhancements and information are stored in a second memory location, separate from the bitmap. A report is

prepared using the information and the image together with its enhancements and/or without them; the report is stored in a third memory location and also printed on the laser printer or possibly transmitted by modem to a remote user.” (Col. 6, lines 28-37).

Citing these teachings, the final Office Action makes the unsupported leap to allege that the teachings of Echerer would obviously lead one skilled in the art to create the claimed “portable CAD program [that] generates a script file comprising any additions or changes made with regard to a CAD file on the portable computing device, wherein the script file is separate from the CAD file.” This is incorrect.

It should be noted that Echerer does not teach or suggest “additions or changes” to an image file. Rather, Echerer merely teaches that the user (presumably a physician) “enhances the image and extracts information from the image.” Obviously, the physician does not add to or change the x-ray image. Thus, the file manipulation taught by Echerer is of an entirely different kind than that claimed by the Applicant.

Moreover, nothing in the cited prior art teaches or suggests that the techniques of Echerer could or should be applied to working with a CAD program and CAD file. The teachings of Echerer are applied only to medical imaging. There is nothing in the prior art to suggest to one of skill in the art that the teachings of Echerer might be applied to a portable CAD program and CAD file.

Consequently, the combined teachings of the Palm Handbook, REH and Echerer fail to teach or suggest that “*additions or changes* made with regard to a CAD file on the portable computing device” are stored in a script file, “wherein the script file is separate from the CAD file.” (emphasis added). Moreover the cited combination fails to teach or suggest any techniques for use with a CAD program and CAD file.

Additionally, Echerer does not expressly teach or suggest that the described enhancements and extracted information are stored in a separate file, only in a different memory location. Data stored in different memory locations can still be part of the same file. Thus, it is reading more into Echerer than is actually there to state that Echerer teaches creating a script file separate from a main file.

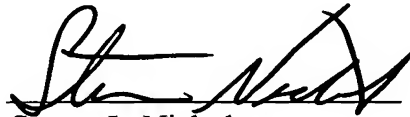
"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 13-24 should be reconsidered and withdrawn.

Dependent claims 7-10, 12, 28 and 36 were rejected under 35 U.S.C. § 103(a) in view of the combined teachings of the Palm Handbook and the REH. Claim 11 was rejected on the same basis and further in view of U.S. Patent No. 5,907,705 to Carter. Claims 23 and 24 were rejected under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook, Echerer and Kung. These rejections are all traversed for at least those reasons given above with regard to the respective independent claims.

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment makes only those changes necessary to place the application in better form for appeal. The amendment corrects obvious typographical errors and combines previous claims 39 and 40. The amendment does not raise new issues requiring further search or consideration. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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